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EXAMINER

CARLSON, JEFFREY D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,945

Applicant(s)

KAO, TZE CHUNG

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-40 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the paper(s) filed 8/29/05.

Specification

2. The disclosure is objected to because of the following informalities:
 - Applicant's amendment filed 8/29/05 is believed to introduce new matter in to the disclosure. Applicant has included the language "posters *built* in each of said regional territories," yet there is no original disclosure consistent with this language. At best, applicant has described the posters as "*provided* in each regional territory." There appears to be no disclosure describing any structure to be built or constructed. Applicant's statement that prior art billboards are generally constructed on a steel support frame is not believed to describe the instant invention of the electronic poster. Applicant is required to delete the newly added subject matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. **Claims 1-4, 7-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dukash et al (WO 01/45065) in view of Lutterbach et al (US5510828) and Giraud (US5966696).**

5. Regarding claims 1-4, 10, 11, 17, 25-28, 33-40, Dukash et al (WO 01/45065). Dukash et al teaches distributed, electronic billboards which receive content from a central controller. Dukash et al teaches computer-based client software (taken to be **regional service centers**) which are connected to a **central control system** (ecommerce site) by a network 348 (the Internet) [pg 49]. Advertisers upload their advertisements and scheduling/timing criteria to the central control which downloads the content and control information to the appropriate billboard. Each of the distributed billboards are controlled by control circuitry which are taken to be **regional control centers** which operate the remote electronic billboard (poster) where the ads are displayed at the appropriate time(s). Dukash et al's regional territories are taken to be inherently defined by the locations of the various elements of the system; the invention of Dukash et al is taken to be carried out in a country. The posters display the digital ads according to the scheduling information. Regarding applicant's "stationary" language, Dukash et al teaches that some of the displays are mounted on vehicles, indicating that some may be mounted in/on other objects [pg 7 paragraph 3, page 8 paragraph 4]. Further, the billboards that are mounted on the vehicles can be considered to be stationary at least when stuck in traffic, when at stoplights and when parked. More importantly, Lutterbach et al teaches remote, stationary billboards which display electronic advertising [fig 1, col 3 lines 43-55] as well as the concept of portable,

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vehicle-mounted electronic billboards that can display content while driving, or can display content when parked and deployed as a stationary billboard for particular events [col 3 lines 10-23]. It would have been obvious to one of ordinary skill at the time of the invention to have operated the billboards of Dukash et al as portable, but stationary event billboards which can be location-sensitive as taught by Dukash et al, This would enable such dynamic advertising for various events such as sporting events, weekend festivals or summer-long carnivals. Various advertisers can request their advertising with various schedules and various requested locations, resulting in potential conflicts; the system's automated system which provides an optimization scheme [10:11-18] to satisfy ad requirements is taken to inherently provide a determining, booking, affirming and confirmation system which enables these different requested ad schedules to co-exist. Regarding the monitoring/feedback, Dukash et al's visual monitoring of the billboard environment [page 9] appears to be for purposes of documenting the presence of crowds in an effort to best select ads according to crowds that are present or are expected to be present. There is no specific mention of capturing viewers responses to the displayed ads and sending this information to the host. Giraud also teaches remotely networked, dynamically displayed billboards. Giraud teaches that sensors (optical sensors or cameras) can be provided at the billboards in order to determine who is nearby and whether they are facing the billboard [col 6 lines 1-24]. More importantly, Giraud teaches delivery of the information to the host for analysis and further that the images from the cameras may be used to analyze patterns related to the viewer which are "indicative of his/her attractiveness to the system." It would have been obvious to

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one of ordinary skill at the time of the invention to have provided such camera-based images/video to the host of Dukash et al in order to determine how attracted the viewers are to the advertising and therefore its effectiveness. It would have been obvious to one of ordinary skill at the time of the invention to have provided such sensed viewer images/video (feedback) in real time in order to get instant measurements of the ad's effectiveness. The size of the ads are inherently defined by the content of the ads. Text ads have a size as defined by the number of words; a 5 word ad can be described as being a 5-word size ad. Dukash et al teaches real time ads on page 12.

Regarding claims 16, 20, Dukash et al teaches providing an ad identifier for each ad on page 36.

Regarding claims 7-9, Official Notice is taken that it is well known to base the timing of ads based on the type of product. It would have been obvious to one of ordinary skill at the time of the invention to have suggested/requested that ads for children's products/services be displayed during the day on weekends when the children are not in school, for example so that the timing of the ad display is more effective. Further, applicant states in the "Description of Related Arts" the obviousness of effective time periods (kids not in school) to display children's advertising. The system of Dukash et al enables a suggested/categorized schedule to be provided to the central control system which results in the ads being shown by the regional control centers which provide the control circuitry to drive the dynamic displays. (It does not appear that applicant is positively claiming any suggestion step, but rather only a "providing" step.)

Regarding claims 12-15, Official Notice is taken that it is well known for businesses to create their own advertisements or to outsource such creative work. It would have been obvious to one of ordinary skill at the time of the invention to have provided ad-creation services so that the business desiring advertising does not have to design the creative ads themselves.

Regarding claims 18, 19, 21, it would have been obvious to one of ordinary skill at the time of the invention to have stored the received orders for advertising in a database so that the orders can be logged and processed. It is well known and would have been obvious to one of ordinary skill at the time of the invention to have created order identifiers with each order so that the orders can be carried out, managed and billed for in a computerized fashion.

Regarding claims 22-24, the requested ad content inherently includes a selected language – the language selected by the requestor.

Regarding claim 29-32, Dukash et al teaches plural ads to be shown in one location [fig 49]. This is taken as a teaching to share the billboard display space, however, it would have been obvious to one of ordinary skill at the time of the invention to have displayed two different ads on the same screen so that more ads can be shown at once, creating more ad revenue.

6. Claims 5, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dukash et al in view of Lutterbach et al and Giraud, further in view of Rakavy et al (US6317789). Rakavy et al teaches automated translation of advertising content into

other languages. It would have been obvious to one of ordinary skill at the time of the invention to have provided such a feature with that of Dukash et al so that ad content can be displayed in different languages, increasing the effectiveness of the ads in areas where different languages are spoken.

Response to Arguments

7. Applicant's arguments filed 8/29/05 have been fully considered but they are not persuasive.

Applicant argues that Dukash et al (WO 01/45065) does not qualify as prior art under 102(e) and gives three reasons: 1) it is not a US application publication or US patent, 2) it was published after the effective filing date of the instant invention, and 3) the effective filing date of Dukash et al is December 15, 1999 which is before November 29, 2000 so that no 102(e) date is available. Examiner disagrees and reiterates that Dukash et al indeed qualifies as prior art under 102(e). As to the above arguments, 1) and 2) are true, but irrelevant to the question of 102(e). Applicant's attention is brought to page 2 of the 102(e) flowchart posted at the USPTO website (<http://www.uspto.gov/web/offices/dcom/olia/aipa/102eflowchart.pdf>) which is retroactively applied to the instant invention for determining prior art 102(e) dates. The International filing date of Dukash et al is December 15, 2000 which is after November 29, 2000 [Dukash et al's US priority dates provided do NOT change the filing date for the International Application (IA)]. Because Dukash et al's WIPO publication was in English and designated the US, the 102(e) date is at least the international filing date

(December 15, 2000) and perhaps either of the earlier US provisional dates, depending on their common subject matter.

Applicant argues that Dukash et al does not teach a stationary poster. As stated above, the billboards of Dukash et al are taken to be stationary at least when stuck in traffic, when at stoplights and when parked. The ability or desire to move something in the future does not prevent an object which is presently standing still from being accurately described as stationary. Further, examiner has included a teaching reference that provides motivation to provide traveling billboards that can be parked, deployed to display ads in a stationary manner in order to advertise at traveling, but extended duration events.

Applicant argues that the references do not teach the regions. As stated above, Dukash et al's regional territories are taken to be inherently defined by the locations of the various elements of the system; the invention of Dukash et al is taken to be carried out in a country.

Applicant argues that Dukash et al does not teach control of the posters on a 24 hour basis. There is no evidence that the Examiner's interpreted control center fails to operate around the clock.

Applicant argues that Dukash et al does not teach translating content into another language. Examiner has relied upon Rakavy et al for such a teaching.

Applicant argues that the references do not teach suggested schedule and reference for different categories of products by each regional control center. However,

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examiner has addressed this by taking official notice and making an obviousness rejection.

Applicant argues that each posting order is sent with a posting code. Page 4 of the previous action pointed out that page 36 of Dukash et al provided such a feature.

Applicant argues that Dukash et al uses wireless and therefore it would be “impossible” to deliver video and audio. Examiner disagrees with such an assessment of impossibility, yet points out that the claims do not require any particular content format.

Applicant argues that that Dukash et al does not teach two poster contents sharing a full screen. Examiner addressed this at page 5 of the previous action; it is repeating in this action.

Applicant argues that that Dukash et al lacks a teaching for real-time monitoring. Examiner addressed this with an obviousness rejection using Giraud.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc